REMARKS

Claims 19 and 28-36 are pending in this application. By this Amendment, Claims 19, 28, 29, and 31 are amended, Claims 22, 25 and 26 are canceled without prejudice or disclaimer of the subject matter contained therein, and Claims 32-36 are added. Favorable reconsideration is respectfully requested in light of the following Remarks.

I. Formal Matters

The Office action objects to the drawings asserting that the feature of a retaining spring being undetachably connected to the carrier plate, as recited in Claim 19, is not shown in the drawings. By this Amendment, Claim 19 is amended to remove the offending language to advance the prosecution of this application. Withdrawal of the objection is respectfully requested.

II. The Claims Satisfy The Requirements of 35 USC §112, Second Paragraph

The Office action rejects Claims 25 and 26 under 35 USC §112, second paragraph asserting that it is unclear how two spring elements can each have a first portion on opposite sides of the piston and also be simultaneously on opposite sides of the piston. By this Amendment, Claims 25 and 26 are canceled to advance prosecution of this application. Withdrawal of the rejection is respectfully requested.

III. The Claims Define Patentable Subject Matter

1. The Office Action rejects Claims 19, 22, 28, 29 and 31 under 35 USC §102(b) over Winter (DE 197 05 803, hereinafter "Winter"). The rejection is respectfully traversed.

Independent Claim 31 specifies, *inter alia*, a brake pad and brake piston assembly comprising a brake piston having an outer surface encircled by a circumferential groove, and a retaining spring coupled to a brake pad, wherein the retaining spring engages the circumferential piston groove, thereby detachably coupling the brake pad to the piston. The retaining spring includes two spring elements arranged opposite each other with respect to the piston axis, each spring element having a first spring portion which applies an axial spring force at a contact point location on opposite sides of the piston to urge the brake pad against the piston, and a third spring element arranged between said two spring elements having a

second spring portion which applies a radial spring force to the brake pad at one contact point location in a vertical direction which is generally perpendicular to the piston axis.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described in a single prior art reference. *See MPEP §2131.* Contrary to the Office action that all of the elements of Claim 31 is disclosed in Winter, at least the feature of a retaining spring including two spring elements arranged opposite each other with respect to the piston axis, each spring element having a first spring portion which applies an axial spring force at a contact point location on opposite sides of the piston to urge the brake pad against the piston, and a third spring element arranged between said two spring elements having a second spring portion which applies a radial spring force to the brake pad at one contact point location in a vertical direction which is generally perpendicular to the piston axis, is not disclosed, taught or suggested in Winter, so the rejection is unsupported by the art and should be withdrawn.

For at least this reason, Claim 31 is allowable over the applied art. Claims 19 and 28-30, which depend from Claim 31, are likewise allowable over the applied art. Withdrawal of the rejection is respectfully requested.

2. The Office Action rejects Claim 30 under 35 USC §103(a) over Winter in view of Verbeeten et al. (U.S. Patent No. 5,8163,370, hereinafter "Verbeeten"). The rejection is respectfully traversed.

Applicant agrees with the Office action that Winter fails to disclose a retaining plate configured as a damping plate. However, Claim 30 depends from Claim 31. It is respectfully submitted that there is no mention in Verbeeten of at least the feature of a retaining spring including two spring elements arranged opposite each other with respect to the piston axis, each spring element having a first spring portion which applies an axial spring force at a contact point location on opposite sides of the piston to urge the brake pad against the piston, and a third spring element arranged between said two spring elements having a second spring portion which applies a radial spring force to the brake pad at one contact point location in a vertical direction which is generally perpendicular to the piston axis, as recited in Claim 31. Thus, the combination of Winter and Verbeeten does not disclose all the claim limitations, as recited in Claim 31, and the Office action fails to establish a *prima facie* case of obviousness. *See MPEP §2143.*

For at least this reason, Claim 30 is allowable over the applied art, taken singly or in combination. Withdrawal of the rejection is respectfully requested.

New independent Claim 32 specifies, *inter alia*, a brake pad and brake piston assembly including the feature of a retaining spring comprising a spring element including three spring portions, two of the three spring portions arranged opposite each other with respect to the piston axis which applies an axial spring force at a contact point location on opposite sides of the piston to urge the brake pad against the piston, and the third spring portion arranged between the other two spring portions which applies a radial spring force to the brake pad at one contact point location in a vertical direction which is generally perpendicular to the piston axis.

It is respectfully submitted that at least this feature is not disclosed, taught or suggested in the applied art.

IV. Conclusion

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance. Favorable consideration and prompt allowance of the application is earnestly solicited.

Should Examiner Pezzlo believe anything further would be desirable in order to place the application in better condition for allowance, the Examiner is invited to contact the undersigned attorney at the telephone number listed below.

It is believed that any additional fees due with respect to this paper have already been identified. However, if any additional fees are required in connection with the filing of this paper, permission is given to charge account number 18-0013 in the name of Rader, Fishman and Grauer PLLC.

Respectfully submitted,

Peter J. Rashid, Registration No. 39464
Joseph V. Coppola, Sr., Registration No. 33373
Rader, Fishman & Grauer PLLC
39533 Woodward Ave., Suite 140
Bloomfield Hills, Michigan 48304
(248) 594-0624
Attorneys for Applicant
Customer No.: 010291

UNITED STATES PATENT AND TRADEMARK OFFICE

UNDER SECRETARY OF COMMERCE FOR INTELLECTUAL PROPERTY AND
DIRECTOR OF THE UNITED STATES PATENT AND TRADEMARK OFFICE
WASHINGTON, DC 20231
www.uspto.gov

OIPE JC10 SEP 15 2003 PATENT & TRADEMARK OFFICE

Paper No.

Notice of Non-Compliant Amendment (Voluntary Revised Practice)

The amendment filed 8/12/03 under the voluntary revised amendment practice guidelines[1], published in the Official Gazette on February 25, 2003 (*Amendments in a Revised Format Now Permitted,* 1267 Off. Gazette 106), does not fully comply with minimal requirements of the voluntary practice. In order for the amendment to be entered, it must either (1) comply with the guidelines of the voluntary revised amendment practice (which practice invokes waivers of certain 37 CFR 1.121(a)-(d) requirements) or (2) comply with current 37 CFR 1.121 requirements.

THE FOLLOWING ITEM(S) IN APPLICANT'S AMENDMENT CAUSES THE AMENDMENT TO BE NON-COMPLIANT WITH THE VOLUNTARY REVISED AMENDMENT PRACTICE.

☑ 1. A complete listing of all of the claims is not present in the amendment paper.

☐ 2. The listing of claims does not include the text of all claims currently under examination.

☐ 3. The claims of this amendment paper have not been presented in ascending numerical order.

☐ 4. Each claim has not been provided with a status identifier, and, as such, the individual status of each claim cannot be determined.

☐ 5. Other: _____

RECEIVED
SEP 16 2003
GROUP 3600

LIE: Check one of the following boxes:

☐ **PRELIMINARY AMENDMENT:** Applicant is given ONE MONTH from the mail date of this letter to re-submit the amendment in compliance with either the guidelines of the revised amendment practice or current 37 CFR 1.121. Failure to comply with either the current 37 CFR 1.121 practice or with the voluntary practice will result in non-entry of the amendment and examination on the merits will commence without entry of the originally proposed preliminary amendment. This notice is not an action under 35 U.S.C. 132, and this ONE MONTH time limit is not extendable.

☐ **AMENDMENT AFTER NON-FINAL ACTION:** Since the above-mentioned reply appears to be a *bona fide* response, applicant is given a TIME PERIOD of ONE MONTH from the mailing of this notice within which to re-submit an amendment which complies with either the voluntary practice guidelines or current 37 CFR 1.121 in order to avoid abandonment. EXTENSIONS OF THIS TIME PERIOD ARE AVAILABLE UNDER 37 CFR 1.136(a).

Paul R. James
[redacted]
LIE36634
703.306.3550

[1] For further explanation of the guidelines of the revised amendment format, please see the posted notice and sample amendment format at: http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/officeflyer.pdf and http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/formatrevamdtprac.pdf